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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,680	06/29/2001	Hiroyuki Ishiwata	208671US	9420
22850	7590	05/05/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/893,680

Applicant(s)

ISHIWATA ET AL.

Examiner

Brenda Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-6,9-15 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 2,7,8,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/30/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1, 2 and 4-20 are pending in the application.

This action is in response to applicants' amendment filed December 30, 2003.

Claims 1, 7, 8, 10, 12, 14, 16, 18 and 20 have been amended and claim 3 has been canceled.

### *Response to Amendment*

Applicant's amendments filed December 30, 2003 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the improper Markush rejection labeled paragraph 1 in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the objections to the specification labeled paragraph 3 in the last office action, which is hereby **withdrawn**.
3. With regards to the rejection of claims 10-12 and 14-20 under 35 USC § 112, first paragraph, labeled paragraph 7 in the last office action, the applicants' stated that it is believed to be obviated by the amendment submit, however claim 16 has not been amended such that method claim 16 has not been limited to treating. Claim 12 is "A method of treating or **reducing** the symptoms of allergic immune disease..." which is not described in the specification.

Claims 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 8 of the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 30, 2003, the following new grounds of rejections apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 2, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 2 is vague and indefinite in that "derivative" in claim 2 implies more than what is positively recited.
- b) Claim 7 is vague and indefinite in that it is not known what is meant by "selected from group". It is believed that the applicants' intended selected from the group.

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c) Claim 8 is vague and indefinite in that it is not known what is meant by the second occurrence of the species N,N'-bis[2-(3,4,5-trimethoxyphenyl)-5-pyridyl]-N,N'-dimethylethylenediamine dimethanesulfonate. See lines 2-3 and lines 6-7 of amended claim 8.

d) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the species spanning lines 8-9, i.e. N,N'-bis[2-(3,4,5-trimethoxyphenyl)-5-pyridyl]-N,N'2,2-tetramethyl-1,3-propanediamine dimethanesulfonate.

e) Claim 8 is vague and indefinite in that it is not known what is meant by the nomenclature of the species spanning lines 12-13, i.e. bis[N-2-(3,4,5-trimethoxyphenyl-5-pyridyl)- 2-aminoethyl]ether dimethanesulfonate which is missing a close parenthesis and an open bracket. It is also noted that the nomenclature includes the N atom inside the brackets.

### ***Allowable Subject Matter***

6. Claims 1, 4-6, 9-15 and 18-20 are allowed. None of the prior art of record nor a search in the pertinent art area teaches the compounds or compositions of the bis(2-aryl-5-pyridyl) compounds as claimed herein.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Brenda Coleman".

Brenda Coleman

Primary Examiner Art Unit 1624

April 29, 2004